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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,469	10/03/2003	Albert Gordon Alexander	NLF-0321	3345

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EXAMINER	
MCAVOY, ELLEN M	
ART UNIT	**PAPER NUMBER**
1764	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,469	ALEXANDER ET AL.	
	Examiner	Art Unit	
	Ellen M. McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29-43 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Germaine et al (WO 02/07036 A1) in combination with Bertomeu (6,599,864) or Murphy et al (6,620,312).

Applicants' arguments filed 14 March 2007 have been fully considered but they are not persuasive. As previously set forth, Germaine et al ["Germaine"] disclose an automatic transmission fluid having a kinematic viscosity at 100°C of between 4 and 10 cSt which comprises an additive package and a base oil wherein the base oil fraction comprises at least 98 wt.% saturates obtained from a paraffinic Fischer-Tropsch product. Germaine teaches that the automatic transmission fluid has a pour point below –30°C, and the base oil component has a viscosity index (VI) between 110 and 150. Germaine teaches that the base oil may be combined with one or more additional base oils selected from mineral base oils and synthetic base oils. Germaine teaches that the automatic transmission fluid preferably contains detergents, dispersants, anti-wear agents, friction-modifiers and other such additives. Germaine teaches that the Brookfield viscosity of the transmission fluid be below 20,000 mPas at –40°C. The examiner maintains the position that the base oil of Germaine is indistinguishible from either the base stock component (I) and/or the Group II or Group III base stock component (II) of the claims

since the properties (a) kinematic viscosity, (b) viscosity index, (c) pour point, and (d) saturates content, may be the same. Although the process steps (i)-(iv) of base stock component (I) are not specifically set forth, the claim is in a product-by-process format and determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Applicants' invention differs by further adding base stock component (I) or by further adding (II) from about 50 vol.% to 80 vol.% of a Group II or Group III basestock. However, such basestocks are well-known in the lubricant art and Germaine allows for the addition of one or more base oils to the automatic transmission fluid selected from mineral oils and synthetic oils.

Bertomeu discloses a branched, isoparaffin hydrocarbon base oil for lubricants having a viscosity index of not less than 130, a kinematic viscosity at 100°C ranging between 3.5 and 4.5 cSt, and a pour point that is less than –18°C. Bertomeu teaches that the base oil may be prepared from hydrotreatment, hydrodewaxing, fractionation and hydrofinishing of cuts and residues resulting from hydrocracking. See column 3, lines 7-57. The examiner maintains the position that the base oil of Bertomeu meets the limitations of either base stock (I) or base stock (II) of the claims. Bertomeu teaches that the base oil may be used for high end lubricants and for use in the automotive industry. Murphy et al ["Murphy"] disclose a method for producing a lube basestock from a waxy feed including slack wax, Fischer-Tropsch wax, waxy raffinates and

waxy distillates to produce a high quality lube oil product having a low pour point, a low viscosity and a high viscosity index (VI). Murphy teaches that the lube basestock may be used in automatic transmission fluids. See columns 9-10.

Having the prior art references before the inventors at the time the invention was made it would have been obvious to the skilled oil formulator to have combined the isoparaffin hydrocarbon base oil of Bertomeu or the basestock of Murphy with the automatic transmission fluid of Germaine to produce a high quality fluid. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is found in Germaine which allows for the addition of one or more base oils to the automatic transmission fluid selected from mineral oils and synthetic oils.

Claim Rejections - 35 USC § 103

Claims 29-43 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,475,960) in combination with Bertomeu (6,599,864) or Murphy et al (6,620,312).

Applicants' arguments filed 14 March 2007 have been fully considered but they are not persuasive. As previously set forth, Bertomeu and Murphy et al ["Murphy"] are relied on as

outlined above. Berlowitz et al ["Berlowitz"] disclose premium synthetic lubricants comprising a synthetic isoparaffinic hydrocarbon base stock and an effective amount of at least one, and typically a plurality of lubricant additives such as a detergent, dispersant, antioxidant, antiwear additive, pour point depressant, VI improver, and the like. The base stocks are derived from waxy Fischer-Tropsch hydrocarbons and process steps include hydroisomerization and dewaxing. Berlowitz teaches that the fully formulated lubricating oils may be used as transmission oils. The base stock set forth in Table 3 has a kinematic viscosity at 100°C of 5.5 cSt, a VI of 145, a pour point of –19°C. The examiner maintains the position that the base oil of Berlowitz is indistinguishible from either the base stock component (I) and/or the Group II or Group III base stock component (II) of the claims since the properties (a) kinematic viscosity, (b) viscosity index, (c) pour point, and (d) saturates content, may be the same. Applicants' invention differs by further adding base stock component (I) or by further adding (II) from about 50 vol.% to 80 vol.% of a Group II or Group III basestock. However, such basestocks are well-known in the lubricant art as evidenced by Bertomeu and Murphy, and Berlowitz also allows for the addition of one or more base oils to the oil composition selected from mineral oils and synthetic oils. See column 2, lines 45-63. Having the prior art references before the inventors at the time the invention was made it would have been obvious to the skilled oil formulator to have combined the isoparaffin hydrocarbon base oil of Bertomeu or the basestock of Murphy with the lubricant compositions of Berlowitz to produce a high quality fluid. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to

do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is found in Berlowitz which allows for the addition of one or more base oils to the lubricating oil compositions selected from mineral oils and synthetic oils.

In response, applicants' amended independent claim 29 to add the limitation that base stock (I) has "(e) a measured-to-theoretical viscosity ratio of less than 1.2", and argues that the prior art including the cited references do not disclose that limitation. Accordingly, applicants request allowance of the application based on the amendment to the claims. This is not deemed to be persuasive because, as set forth above, base stock (I) appears to be taught by either Germaine or Berlowitz since the properties (a) kinematic viscosity, (b) viscosity index, (c) pour point, and (d) saturates content, may be the same. Although not disclosed by Germaine or Berlowitz, the examiner is of the position that the base oils of the prior art may also have a measured-to-theoretical viscosity ratio of less than 1.2 since the other properties of (a) kinematic viscosity, (b) viscosity index, (c) pour point, and (d) saturates content, may be the same. Further, it is not clear how the "theoretical viscosity" is measured.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
May 16, 2007